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LADAS & PARRY				
5670 WILSHIRE BOULEVARD, SUITE 2100				
LOS ANGELES, CA 90036-5679				
EXAMINER				
RANGREJ, SHEETAL				
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3626				
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10/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/692,321

**Applicant(s)**

MONK, SIMON

**Examiner**

SHEETAL R. RANGREJ

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Prosecution History Summary***

1. Claims 1, 2, and 14 are amended.
2. Claims 1-24 are pending.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/18/2008 has been entered.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6, 14-15, and 18 are rejected under 35 U.S.C. 102(e) as being taught by White et al. (U.S. Publication No. 2002/0091550).

6. As per claim 1, White teaches a method of providing an insurance product via a computing network, comprising the steps of: obtaining information from a subscriber (**White: para. 95**); offering an insurance product to the subscriber for a determined cost (**White: para. 0095**); issuing the insurance product to the subscriber, upon payment of the determined cost (**White: para. 0125-0126**); and allowing the subscriber to access the computing after the insurance product has been issued to the subscriber, and allowing the subscriber to vary at least one term of the issued insurance product, by calculating an additional cost dependent on the variation, wherein on the subscriber paying the additional cost, the insurance product term is varied (**White: para. 0103 i.e. update functionality; para. 0122; para. 0131**).
7. As per claim 2, the method of claim 1 is as described. White further teaches wherein the variations the subscriber can make include an extension of the period of the subscribers insurance policy or the area covered by the subscriber's insurance policy (**White: para. 0122-0123; 0140**).
8. As per claim 3, the method of claim 2 is as described. White further teaches comprising the further step of, before issuing the insurance product to the subscriber, obtaining information from the subscriber, the information being applied to calculate the cost of the insurance product (**White: figure 4**).
9. As per claim 6, the method of claim 3 is as described. White further teaches comprising the further step of verifying the identity of the subscriber before obtaining information from the subscriber (**White: figure 2, 330**).

10. As per claim **14**, it is a system claims which repeat the same limitations as claim **1**, the corresponding method claim, as a collection of elements as opposed to a series of process steps. Since the teachings of **White** disclose the underlying process steps that constitute the method of claim **1**, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims **14** are rejected for the same reasons given above for claims **1**.

11. System claims 15 and 18 repeat the subject matter of claims 3 and 6, respectively, rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of White in the above rejection of claims 3 and 6, respectively, it is readily apparent that the White reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 3 and 6, respectively, and incorporated herein.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-5, 10, 16-17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265).

14. As per claim 4, the method of claim 3 is as described. White does not teach comprising the further step of applying the information obtained from the subscriber to locate a value in one of a table and a multi-dimensional array of data, the value being the purchase cost of the insurance product.

Kleinberg teaches comprising the further step of applying the information obtained from the subscriber to locate a value in one of a table and a multi-dimensional array of data, the value being the purchase cost of the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White and Kleinberg with the motivation that insurance policies respond to different customer description data and therefore help customers by providing a preferential ranking of quotes that could be used for insurance (**Kleinberg: para. 0020**).

15. As per claim 5, the method of claim 4 is as described. White does not teach comprising the further step of utilizing a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term of the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

Kleinberg teaches comprising the further step of utilizing a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber

when the subscriber varies the at least one term of the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

The motivation to combine the teachings is the same as claim 4.

16. As per claim 10, the method of claim 1 is as described. White does not teach wherein the at least one term of the insurance product is the time period for which the insurance product is valid.

Kleinberg teaches wherein the at least one term of the insurance product is the time period for which the insurance product is valid (**Kleinberg: para. 0038**). The examiner interprets that the length of trip is the same as time period for which the insurance product is valid.

The motivation to combine the teachings is the same as claim 4.

17. System claims 16-17 and 21 repeat the subject matter of claims 4-5 and 10, respectively, rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of White in view of Kleinberg in the above rejection of claims 4-5 and 10, respectively, it is readily apparent that the White in view of Kleinberg references include a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 4-5 and 10, respectively, and incorporated herein.

18. Claims 7-9 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Provost et al. (U.S. Patent No. 6,341,265).

19. As per claim 7, the method of claim 1 is as described. White does not teach comprising the further step of, after issuing the insurance product to the subscriber, obtaining claim information relating to a claim for compensation made by the subscriber, the claim information being applied to determine whether the subscriber is entitled to receive compensation for the claim.

Provost teaches comprising the further step of, after issuing the insurance product to the subscriber, obtaining claim information relating to a claim for compensation made by the subscriber, the claim information being applied to determine whether the subscriber is entitled to receive compensation for the claim (**Provost: figure 3 & 4B**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White and Provost with the motivation that careful review of payment requests minimizes fraud and unintentional errors and provides consistency of payment (**Provost: col. 1, 31-38**).

20. As per claim 8, the method of claim 7 is as described. White does not teach comprising the further step of comparing the claim information to a predetermined rule set, and providing appropriate compensation to the subscriber if the claim information complies with the predetermined rule set.

Provost teaches comprising the further step of comparing the claim information to a predetermined rule set, and providing appropriate compensation to the subscriber if the claim information complies with the predetermined rule set (**Provost: col. 4, 7-21**).

The motivation to combine the teachings is the same as claim 7.



21. As per claim 9, the method of claim 7 is as described. White does not teach comprising the further step of communicating the claim information to an insurance underwriter for further processing.

Provost teaches comprising the further step of communicating the claim information to an insurance underwriter for further processing (**Provost: col. 1, 64 to col. 3, 13**).

The motivation to combine the teachings is the same as claim 7.

22. System claims 19-20 repeat the subject matter of claims 7 and 9, respectively, rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of White in view of Provost in the above rejection of claims 7 and 9, respectively, it is readily apparent that the White in view of Provost references include a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 7 and 9, respectively, and incorporated herein.

23. Claims 11-13 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Mori et al. (U.S. Patent No. 6,070,148).

24. As per claim 11, the method of claim 1 is as described. White does not teach wherein the at least one term of the insurance product is the intended destination of the subscriber.

Mori teaches wherein the at least one term of the insurance product is the intended destination of the subscriber (**Mori: figure 14**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White and Mori with the motivation to provide an electronic

commerce system in which information concerning a commodity or service can be provided to a user in a suitable timing (**Mori: col. 2, 44-53**).

25. As per claim 12, the method of claim 1 is as described. White does not teach wherein the at least one term of the insurance product is the total coverage value of the insurance policy.

Mori teaches wherein the at least one term of the insurance product is the total coverage value of the insurance policy (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 11.

26. As per claim 13, the method of claim 1 is as described. White does not teach wherein the insurance product is travel insurance.

Mori teaches wherein the insurance product is travel insurance (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 11.

27. System claims 22-24 repeat the subject matter of claims 11-13, respectively, rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of White in view of Mori in the above rejection of claims 11-13, respectively, it is readily apparent that the White in view of Mori references include a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 11-13, respectively, and incorporated herein.

#### ***Response to Arguments***

28. Applicant's arguments filed for claims 1-24 have been fully considered but they are not persuasive.

29. Applicant argues that White does not disclose a method allowing the subscriber to vary the issued insurance product after the insurance product has been issued. Examiner disagrees. White teaches that the generated offer is stored for subsequent retrieval and stored offers may also be subject to modification (White: para. 122-124), thus teaching a method allowing the subscriber to vary the issued insurance product after the insurance product has been issued.

30. In construing a claim term the Examiner must give the claim term its plain and ordinary meaning unless the inventor specifically defines a term. In giving a claim term its plain and ordinary meaning, the Examiner can give the claim its broadest reasonable interpretation. In re Baker Hughes, Inc., 215 F.3d 1297 (Fed. Cir. 2000). Applicant argues that White does not teach a method of allowing the subscriber to vary an issued insurance product, but instead teach only methods related to providing an "offer" of an insurance product. Examiner disagrees. White teaches "offers" that are stored in a database for an applicant. When the applicant received an offer for an insurance product, the offer is saved within the application and the issued insurance is provided to the subscriber. The subscriber when choosing to modify the insurance product, obtains the "offer" to make few modifications and purchase a modified insurance product; therefore allowing the subscriber to vary an issued insurance product.

### ***Conclusion***

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/SRR/  
Patent Examiner  
September 27, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3626